REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-24 and 42-48 are currently pending. Claims 26-41 and 50-69 have been cancelled without prejudice or disclaimer; Claims 1, 3-6, 9, 11, 12, 14, 17-19, 21-24, 42,43, and 46-48 have been amended; and Claims 70-75 have been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.[1]

In the outstanding Office Action, Claims 1-11, 18-21, and 42-45 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1-14, 17-24, and 42-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,317,786 to Yamane et al. (hereinafter "the '786 patent"); and Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '786 patent in view of U.S. Patent Application Publication No. 2004/0133656 to Butterworth et al. (hereinafter "the '656 application").

REJECTION UNDER 35 U.S.C. § 112

Applicant respectfully traverses the rejection of Claims 1-11, 18-21, and 42-45 under 35 U.S.C. § 112, first paragraph. The Office Action acknowledges that a controller (1300) is depicted in Fig. 2 and described at pages 60-62 of the specification, but asserts that "[t]he controller was added to overcome the 101 rejection but it doesn't include those 'parts' as defined in claims 1, 18, and 42.[2]

However, it is noted that MPEP § 2163.02 provide that:

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[1] See, e.g., Figs. 7-9, and the discussion related thereto in the present application.
[2] See Office Action dated November 28, 2008, page 8.

> [w]henever the issue arises, the fundamental factual inquiry is whether the specification <u>conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed</u>. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).
>
> The subject matter of the claim need <u>not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement</u>.

Further, for a non-limiting example, it is noted that the specification clearly discloses that the controller 1300 includes a CPU 1304, and that the CPU 1304 executes the document management Web service application 1216.[3] For example, with respect to Fig. 4, the specification discloses that the document management web application 1216 of an image forming apparatus 1200 includes a server part 100, a document management Web service execution part 130, a client part 200, and a document process control part 300.[4] Thus, the specification clearly discloses that the controller 1300 includes the "parts," as defined in Claims 1, 18, and 42.

Accordingly, as the originally filed specification conveys with reasonable clarity to those skilled in the art, as of the filing date sought, that Applicant was in possession of the invention as now claimed, it is respectfully requested that the rejection of Claims 1-11, 18-21, and 42-45 under 35 U.S.C. § 112, first paragraph, be withdrawn.

REJECTION UNDER 35 U.S.C. § 102

Amended Claim 1 is directed to a Web service providing apparatus, comprising:

a controller including

> *a server processing part configured to control receipt of a process request for a process from a requesting apparatus, connected to the Web service providing apparatus via a communication network, and transmission of a process response corresponding to the process request to the requesting*

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[3] See page 60, lines 22-24 and page 61, line 20-25 of Applicant's specification.
[4] Id. at page 65 ,line 23 to page 66, line 3.

> *apparatus in accordance with a predetermined protocol, the process request including a command to retrieve target information from an image forming apparatus connected to the Web service providing apparatus via the communication network;*
>
> *a condition acquisition control part configured to control, in response to an instruction from the server processing part, acquisition of the target information designated by the process request from the image forming apparatus that manages the target information based on a first processable condition; and*
>
> a service providing part configured to perform the requested process on the target information and to send a result of the process to the server processing part.

Regarding the rejection of Claim 1 under 35 U.S.C. § 102(e), the '786 patent is directed to a web service system that allows a system operator to manage multiple web servers. In particular, the '786 patent discusses a web service system 90 including various components 100-122 that can communicate over one or more computer networks. The '786 web service system 90 manages one or more hosts 100, that can be a computer system commercially available and capable of using a multi-threaded operating system such as UNIX or Windows NT, each including at least one web server 102.[5] The '786 patent discusses that a user interacts with the web server by making an initial request to the web server 102, which results in the web server 102 sending a web page in response, an aggregation of related web pages presented to the user being referred to as an application.[6] Further, the '786 patent discusses that the web service system 90 includes an interceptor 120 and manager 110 that perform load balancing,[7] and that the manager 110 monitors the hosts 100 based on information received from agents 106 included in the hosts 100.[8]

The Office Action asserts that the '786 manager 110, the agent 106, and the application representing an aggregation of related web pages correspond to the "server

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[5] See '786 patent, column 4, lines 15-37.
[6] Id. at column 4, line 38 to column 5, line 28.
[7] Id. at column 7, lines 6-28.
[8] Id. at column 6, lines 46-65.

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processing part," the "condition acquisition control part," and the "service providing part,"

respectively, as defined in Claim 1.[9]

However, it is respectfully submitted that the '786 patent fails to disclose <u>a server</u>

<u>processing part configured to control receipt of a process request for a process from a</u>

<u>requesting apparatus, connected to the Web service providing apparatus via a communication</u>

<u>network, and transmission of a process response corresponding to the process request to the</u>

<u>requesting apparatus in accordance with a predetermined protocol, the process request</u>

<u>including a command to retrieve target information from an image forming apparatus</u>

<u>connected to the Web service providing apparatus via the communication network</u>. Rather,

as cited in the Office Action, the '786 patent simply discusses that the manager 110

coordinates the components of the web service system, and tracks the status of the

components.[10] The '786 patent does not disclose that the manager 110 is configured to

control receipt of a process request that includes *a command to retrieve target information*

from an image forming apparatus connected to the Web service providing apparatus via

the communication network.

Further, it is respectfully submitted that the '786 patent fails to disclose <u>a condition</u>

<u>acquisition control part configured to control, in response to an instruction from the server</u>

<u>processing part, acquisition of the target information designated by the process request from</u>

<u>the image forming apparatus that manages the target information based on a first processable</u>

<u>condition</u>. Rather, as noted in the Office Action, the '786 patent simply discusses that web

pages presented to the user in response to web page requests from the user's browser can be

stored on a host 100 or on a file system accessible to the web server 102, or they can be

generated by the web server 102 by processing data available to the web server 102.[11] That

is, the '786 patent discusses that the web server 102, not the agent 106, present web pages in

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[9] See Office Action dated November 28, 2008, pages 9 and 10.
[10] See '786 patent, column 16, lines 19-31.
[11] Id. at column 5, lines 30-45.

response to the web page requests.[12] The '786 patent does not disclose that the agent 106, or

the web server 102, is configured to control, in response to an instruction from the server

processing part, acquisition of target information *designated by the process request*

(including a command to retrieve target information from an image forming apparatus

connected to the Web service providing apparatus via the communication network) *from the*

image forming apparatus that manages the target information based on a first processable

condition.

Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent

claims) patentably defines over the '786 patent.

Amended Claim 17 recites, in part,

> a server processing step of controlling receipt of a
> process request for a process from a requesting apparatus,
> connected to the Web service providing apparatus via a
> communication network, and transmission of a process
> response corresponding to the process request to the requesting
> apparatus in accordance with a predetermined protocol, the
> process request including a command to retrieve target
> information from an image forming apparatus connected to the
> Web service providing apparatus via the communication
> network; and

> a condition acquisition control step of controlling,
> corresponding to an instruction from the server processing step,
> acquisition of the target information designated by the process
> request from the image forming apparatus that manages the
> target information based on a first processable condition.

As noted above, the '786 patent fails to disclose the "server processing part" and the

"condition acquisition control part" of Claim 1. Thus, the '786 patent fails to disclose the

server processing step and the condition acquisition control step recited in Claim 17.

Accordingly, it is respectfully submitted that Claim 17 patentably defines over the '786

patent.

Amended Claim 18 is directed to a Web service providing apparatus, comprising:

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[12] See '786 patent, column 6, lines 7-11.

a controller including

> *a service providing part configured to manage target information and to provide the target information to an image forming apparatus, which requests the target information based on a process request including a command to retrieve the target information from the Web service providing apparatus and performs a process on the target information, in accordance with a first processable condition received from the image forming apparatus;*

a process request interpretation part configured to interpret the process request to request the process in accordance with a predetermined protocol and to inform the service providing part of the process; and

a process response creation part configured to create a process response to indicate a result of the process in accordance with the predetermined protocol.

Regarding the rejection of Claim 18 under 35 U.S.C. § 102(e), as noted above, the

'786 patent is directed to a web service system that allows a system operator to manage

multiple web servers. In particular, the Office Action asserts that the '786 application

representing an aggregation of related web pages, the interceptor 120, and the web interface

104 correspond to the "service providing part," the "process request interpretation part," and

the "process request creation part," respectively, as defined in Claim 18.[13]

However, it is respectfully submitted that the '786 patent fails to disclose <u>a service</u>

<u>providing part configured to manage target information and to provide the target information</u>

<u>to an image forming apparatus, which requests the target information based on a process</u>

<u>request including a command to retrieve the target information from the Web service</u>

<u>providing apparatus and performs a process on the target information, in accordance with a</u>

<u>first processable condition received from the image forming apparatus</u>. Rather, as noted

above, the '786 patent simply discusses that the cited application represents an aggregation of

related web pages presented to a user as a set of web pages about a related topic, or from a

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[13] See Office Action dated November 28, 2008, page 16.

particular source.[14] The '786 patent does not disclose that the application is configured to manage target information and to provide the target information to *an image forming apparatus*, which requests the target information *based on a process request including a command to retrieve the target information from the Web service providing apparatus and performs a process on the target information*.

Accordingly, it is respectfully submitted that Claim 18 (and all associated dependent claims) patentably defines over the '786 patent.

Amended Claim 22 recites, in part,

> a service providing step of managing target information
> and providing the target information to an image forming
> apparatus, which requests the target information based on a
> process request including a command to retrieve the target
> information from the Web service providing apparatus and
> performs a process on the target information, based on a first
> processable condition received from the processing apparatus.

As noted above, the '786 patent fails to disclose the "service providing part" of Claim 18. Thus, the '786 patent fails to disclose the service providing step recited in Claim 22. Accordingly, it is respectfully submitted that Claim 22 patentably defines over the '786 patent.

Amended Claim 23, is directed to a terminal, comprising:

> a display unit;

> *a process request creation part configured to create a*
> *process request to cause a first image forming apparatus to*
> *acquire target information managed by a second image*
> *forming apparatus from the second image forming apparatus*
> *and perform a process on the target information in accordance*
> *with a predetermined protocol, the process request being*
> *transmitted to the first image forming apparatus and including*
> *a command to retrieve target information from the second*
> *image forming apparatus, wherein the first image forming*
> *apparatus, the second image forming apparatus, and the*
> *terminal are connected to each other via a communication*
> *network;*

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[14] See '786 patent, column 5, lines 6-9.

a process response interpretation part configured to interpret a process response corresponding to the process request and to acquire a result of the process performed by the first image forming apparatus; and

a display control part configured to display the result of the process on the display unit of the terminal.

Regarding the rejection of Claim 23 under 35 U.S.C. § 102(e), as noted above, the '786 patent is directed to a web service system that allows a system operator to manage multiple web servers. In particular, the Office Action asserts that the '786 agent 106 interface with the web server interface 104, the agent 106 interface with the web server 102, and the console 116 correspond to the "process request creation part," the "process response interpretation part," and the "display control part," respectively, as defined in Claim 23.[15]

However, it is respectfully submitted that the '786 patent fails to disclose <u>a process request creation part configured to create a process request to cause a first image forming apparatus to acquire target information managed by a second image forming apparatus from the second image forming apparatus and perform a process on the target information in accordance with a predetermined protocol, the process request being transmitted to the first image forming apparatus and including a command to retrieve target information from the second image forming apparatus, wherein the first image forming apparatus, the second image forming apparatus, and the terminal are connected to each other via a communication network.</u> Rather, the '786 patent simply discusses that the '786 web server interface 104 transmits, over a shared memory communications channel, information about each web page request to the agent 106, as it is processed.[16] Further, the '786 patent illustrates, in Fig. 1, that the web server interface 104 and the agent 106 are included in the host 100. The '786 patent does not disclose that the '786 agent 106 interface with the web server interface 104 is configured to create a process request (including a command to retrieve target information

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[15] See Office Action dated November 28, 2008, page 19.
[16] See '786 patent, column 12, lines 22-25.

from the second image forming apparatus) *to cause a first imaging apparatus to acquire*

target information managed by a second image forming apparatus *from the second image*

forming apparatus.

Accordingly, it is respectfully submitted that Claim 23 patentably defines over the

'786 patent.

Amended Claim 24 recites, in part,

> a process request creation step of creating a process
> request to request a first image forming apparatus to acquire
> target information managed by a second image forming
> apparatus from the image forming second apparatus and
> perform a process on the target information in accordance with
> a predetermined protocol, the process request being transmitted
> to the first image forming apparatus and including a command
> to retrieve target information from the second image forming
> apparatus, wherein the first image forming apparatus, the
> second image forming apparatus, and the terminal are
> connected to each other via a communication network.

As noted above, the '786 patent fails to disclose the "process request creation part" of

Claim 23. Thus, the '786 patent fails to disclose the process request creation step recited in

Claim 24. Accordingly, it is respectfully submitted that Claim 24 patentably defines over the

'786 patent.

Amended Claim 42 recites, in part,

> a service providing part configured to perform, in
> response to a process request, a process on target information
> received from an image forming apparatus that manages the
> target information in accordance with a first processable
> condition and to provide a result of the process to the image
> forming apparatus, the process request including a command to
> retrieve the target information from the image forming
> apparatus.

Amended Claim 46 recites, in part,

> a service providing step of performing, in response to a
> process request, a process on target information received from
> an image forming apparatus managing the target information in
> accordance with a first processable condition and providing a
> result of the process to the image forming apparatus, the

process request including a command to retrieve the target
information from the image forming apparatus.

As noted above, the '786 patent fails to disclose the "service processing part" and the

"condition acquisition control part" of Claim 1. Thus, the '786 patent fails to disclose the

service providing part and the service providing step recited in Claims 42 and 46,

respectively. Accordingly, it is respectfully submitted that Claims 42 and 46 (and all

associated dependent claims) patentably define over the '786 patent.

Amended Claim 47 recites, in part,

> a process request creation part configured to create a
> process request to cause a first image forming apparatus to
> perform a process on target information managed by a second
> image forming apparatus by sending the target information to
> the first image forming apparatus in accordance with a
> predetermined protocol, the process request being transmitted
> to the first image forming apparatus and including a command
> to retrieve the target information from the second image
> forming apparatus, wherein the first image forming apparatus,
> the second image forming apparatus, and the terminal are
> connected to each other via a communication network.

Amended Claim 48 recites, in part,

> a process request creating step of creating a process
> request to cause a first image forming apparatus to perform a
> process on target information managed by a second image
> forming apparatus by sending the target information to the first
> image forming apparatus, the process request being transmitted
> to the first image forming apparatus and including a command
> to retrieve the target information from the second image
> forming apparatus, wherein the first image forming apparatus,
> the second image forming apparatus, and the terminal are
> connected to each other via a communication network.

As noted above, the '786 patent fails to disclose the "process request creation part" of

Claim 23. Thus, the '786 patent fails to disclose the process request creation part and the

process request creating step recited in Claims 47 and 48, respectively. Accordingly, it is

respectfully submitted that Claims 47 and 48 patentably define over the '786 patent.

REJECTION UNDER 35 U.S.C. § 103

Regarding the rejections of dependent Claims 15 and 16 under 35 U.S.C. § 103(a), it is respectfully submitted that the '656 application fails to remedy the deficiencies of the '786 patent, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 15 and 16 patentably define over any proper combination of the '786 patent and the '656 application.
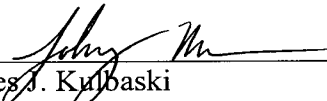
CONCLUSION

The present amendment also sets forth new Claims 70-75 for examination on the merits. No new matter has been added. It is respectfully submitted that these more detailed features are not disclosed or suggested by the applied references.

Thus, it is respectfully submitted that independent Claims 1, 17, 18, 22-24, 42, and 46-48 (and all associated dependent claims) patentably define over any proper combination of the '786 patent and the '656 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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